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KAYE SCHOLER LLP
DAVID S. BENYACAR
DANIEL L. REISNER
425 Park Avenue
New York, NY 10022-3598
Telephone: (212) 836-8000
Facsimile: (212) 836-8689
dbenyacar@kayescholer.com
dreisner@kayescholer.com

Attorneys for Defendant
TIME WARNER CABLE INC.

GOODWIN PROCTER LLP
BENJAMIN HERSHKOWITZ
JOHN F. PETRSORIC
599 Lexington Avenue
New York, NY 10022
Telephone: (212) 813-8800
Facsimile: (212) 355-3333
bhershkowitz@goodwinprocter.com
jpetrsoric@goodwinprocter.com

Attorneys for Defendant
CSC HOLDINGS, INC.

UNITED STATES DISTRICT COURT
NORTHERN DISTRICT OF CALIFORNIA

In Re ACACIA MEDIA TECHNOLOGIES CORPORATION	Case No. C-05-01114JW **ROUND 3 DEFENDANTS' OPPOSITION TO PLAINTIFF'S MOTION FOR RECONSIDERATION OF THE COURT'S THIRD AND FOURTH CLAIM CONSTRUCTION ORDERS** Date: August 17, 2007 Time: 9:00 a.m. Courtoom: Honorable James Ware

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PRELIMINARY STATEMENT

The Round 3 Defendants[1] submit this memorandum in opposition to Acacia's motion for reconsideration of the Court's constructions of selected terms in its Third Claim Construction Order dated December 14, 2006 ("Markman III").[2] The memorandum also addresses Acacia's arguments regarding claims 45 and 46 of the '992 Patent, which are set forth in its separate, untimely brief regarding those claims.[3]

As discussed below, the Court's constructions of the claim terms at issue are well-reasoned and correct. With the exception of one clarification to the construction of "sequence of addressable data blocks" agreed to by Acacia and the Round 3 Defendants, there is no reason to disturb the Court's constructions of these terms.

ARGUMENT

I. THE COURT'S MARKMAN III CONSTRUCTION OF "TRANSMISSION SYSTEM" IS CORRECT

This Court has repeatedly and correctly recognized that the patents-in-suit (the "Yurt patents") use the term "transmission system" to signify something different from, and incompatible with, the plain meaning of "transmission system." From the very first time the Court considered the term, in its First Claim Construction Order dated July 12, 2004 ("July 12 Order"), the Court's construction reflected the fact that the specification gave the term "transmission system" a special meaning that is different from its ordinary meaning. As the Court explained:

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[1]The Round 3 Defendants are Time Warner Cable Inc. and CSC Holdings, Inc. Because each of these two defendants is entitled to a separate 25 page opposition brief pursuant to L.R. 7-4(b), this combined opposition brief, which is less than 50 pages long, is believed to comply with that rule.

[2]Although Acacia also challenges the Court's Fourth Claim Construction Order dated March 2, 2007 ("Markman IV"), Acacia does not take issue with any of the new constructions set forth in that Order. Therefore, it seems Acacia's only issue with Markman IV is that the Court adhered to the challenged constructions from Markman III.

[3]On April 27, 2007, on consent of all of the parties, the Court ordered Acacia's opening brief to be filed by May 18, 2007. The brief Acacia filed on that day did not address claims 45 and 46 of the '992 patent. Instead, without seeking or obtaining leave of Court or the consent of defendants, Acacia filed a separate brief addressing claims 45 and 46 on May 23, 2007.

> In the July 12 Order, the Court treated 'transmission system' as a term with a special meaning, namely, 'an assembly of elements, hardware and software, that function together to convert items of information for storage in a computer compatible form and subsequent transmission to a reception system.' (July 12 Order at 27-28). The Court's July 12 definition recognizes that by 'transmission system' the patentee meant something more than an apparatus which 'transmits.'

(Markman III at 6.)

In Markman III, the Court reaffirmed its conclusion that the patents impart a special meaning to the phrase "transmission system." However, the Court correctly concluded that it should modify its earlier construction because "the July 12 Order recognize[d] some but not all of the components of what the patentee meant by the phrase 'transmission system.'" (*Id.*) Accordingly, the Court construed "transmission system" as follows:

> An apparatus which comprises the following interconnected components: a source material library means, an identification encoding means, a conversion means, an ordering means, a compression means, a compressed data storing means (as illustrated in the block diagram labeled Figure 2a), and a compressed data storage means and a transmitter means (as illustrated in the block diagram labeled Figure 2b). The corresponding structure for each means is the structure identified in the specification for performing the recited function.

(Markman III at 8.) Acacia criticizes the foregoing construction in a variety of respects, each of which is answered below.

A. The Court Properly Construed the Term "Transmission System" in Light of the Specification, Rather than Employing a Dictionary Definition

Acacia argues that the term "transmission system" should be construed in accordance with its plain meaning as provided in the IEEE Dictionary.[4] However, it completely ignores the fact that this plain meaning does not cover the "transmission system" which is disclosed and claimed in the Yurt patents. The IEEE Dictionary defines "transmission system" as the distinct set of components that together "transmit signal waves." The "transmission system" disclosed and claimed in the Yurt patents, however, includes many components having nothing to do with the transmission of the signals, such as storage libraries and an identification encoder. Because the dictionary definition of "transmission system" is incompatible with the use of the term in the Yurt patents, and excludes the transmission system actually disclosed in the specification, it is clear that the patentees coined a new meaning for the term. The specification is the only source for determining what that meaning is, and in the specification, "transmission system" is defined to mean the system described in column 2 and depicted in figure 2.[5]

Acacia acknowledges in its brief that patentees cannot claim more broadly than what is disclosed in the specification. Therefore, Acacia argues that the specification, including the originally filed claims, discloses many different transmission systems. However, all of the excerpts from the specification relied on by Acacia, including the originally filed claims, confirm that the specification discloses only one "transmission system," which is described at column 2 and depicted in figure 2. All of these excerpts also demonstrate that the Court's construction accurately and precisely captures this one transmission system. Indeed, the patentees considered their "transmission system," as construed by the Court, to be the invention itself.

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[4]*The New IEEE Standard Dictionary of Electrical and Electronic Terms* 1405 (5th ed. 1993).

[5]Citations to the common specification of the Yurt patents herein are to the '992 patent unless otherwise indicated.

Finally, even if Acacia was correct that the specification discloses different transmission systems, this would not support Acacia's argument that the Court should construe "transmission system" pursuant to its plain meaning because the plain meaning does not cover any of these alleged embodiments. All of the alleged embodiments have storage libraries, identification encoders and other elements that are excluded by the plain meaning of "transmission system." Instead, the Court's construction would *still be the correct construction*, as it is the broadest construction of "transmission system" contemplated and disclosed by the patentees.

As discussed further below, the Court was compelled for all of these reasons to construe "transmission system" in accordance with the special meaning that the patentees gave the term.

1. The law

Acacia misstates the law when it asserts that a claim term must be given its ordinary and accustomed meaning unless the specification explicitly sets forth a different definition. (Acacia Br. at 2, 4-5.)[6] Indeed, the proposition urged by Acacia was expressly repudiated by the Federal Circuit's *en banc* decision in *Phillips v. AWH Corp.*, 415 F.3d 1303, 1320-24 (Fed. Cir. 2005) (*en banc*).

In *Phillips*, the Court explained that "the person of ordinary skill in the art is deemed to read the claim term not only in the context of the particular claim in which the disputed term appears, but in the context of the entire patent, including the specification." *Phillips,* 415 F.3d at 1313. The Court noted that "patentees frequently use terms idiosyncratically," *id.* at 1314, and that "the specification may reveal a special definition given to a claim term by the patentee that differs from the meaning it would otherwise possess. In such cases, the inventor's lexicography governs." *Id.* at 1316. Therefore, "[i]t is entirely appropriate for a court, when conducting claim construction, to rely heavily on the written description for guidance as to the meaning of the claims." *Id.* at 1317.[7]

---

[6]"Acacia Br." herein refers to Plaintiff Acacia Media Technologies Corporation's Memorandum of Points and Authorities in Support of its Motion for Reconsideration of Certain Claim Construction Terms Construed by the Court in its Third Claim Construction Order and its Forth Claim Construction Order, filed 5/18/07.

The *Phillips* Court then turned to the argument, asserted by Acacia here, that a claim term is presumed to have its ordinary meaning unless the specification explicitly states otherwise. *Id.* at 1320-24. The Court rejected such an approach as "improperly restrict[ing] the role of the specification in claim construction." *Id.* at 1320. The Court explained that "requiring that any definition of claim language in the specification be express, is inconsistent with our rulings that the specification is 'the single best guide to the meaning of a disputed term,' and that the specification 'acts as a dictionary when it expressly defines terms used in the claims or when it defines terms by implication.'" *Id*. at 1321 (citations omitted). Thus, even a claim term with a plain, well-understood meaning can be defined in the specification by implication if the patentees use the term to refer to something different than the plain meaning. *Honeywell Int'l, Inc. v. Universal Avionics Corp.*, 2007 U.S. App. LEXIS 15820, (Benyacar Decl. Ex. H), at *6 (Fed. Cir. July 3, 2007) (construing the claim term "heading" to mean "bearing" because "[t]he specification and the prosecution history make clear . . . that the patentees used the term 'heading' in a manner different from its ordinary meaning.").

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[7] *See also Netword, LLC v. Centraal Corp.*, 242 F.3d 1347, 1352 (Fed. Cir. 2001) ("The claims are directed to the invention that is described in the specification; they do not have meaning removed from the context from which they arose."); *The Toro Co. v. White Consol. Indus., Inc.*, 199 F.3d 1295, 1299 (Fed. Cir. 1999) ("[W]ords of ordinary usage must nonetheless be construed in the context of the patent documents. Thus the court must determine how a person of experience in the field of this invention would, upon reading the patent documents, understand the words used to define the invention."); *Renishaw PLC v. Marposs Societa' per Azioni*, 158 F.3d 1243, 1250 (Fed. Cir. 1998) ("[T]he interpretation to be given a term can only be determined and confirmed with a full understanding of what the inventors actually invented and intended to envelop with the claim.").

As the Federal Circuit also pointed out in *Phillips*, it has been settled law for over a century that claims cannot have a broader scope than what is disclosed in the specification. *See Phillips*, 415 F.3d at 1323 (observing that in *Snow v. Lake Shore & Mich. S. Ry. Co.*, 121 U.S. 617, 630 (1887), "it was clear from the specification that there was 'nothing in the context to indicate that the patentee contemplated any alternative' embodiment to the one presented"); *Wang Labs., Inc. v. Am. Online, Inc.*, 197 F.3d 1377, 1383 (Fed. Cir. 1999) (limiting claims to the "only embodiment described in the '669 patent"). Acacia itself acknowledges that a claim term cannot be construed more broadly than the use of the term in the specification, even if the term has a broader plain meaning. As Acacia says in its discussion of the Court's construction of "sequence of addressable data blocks":

> The facts of the present case are similar to those in *Toro Co. v. White Consolidated Industries, Inc.*, 199 F.3d 1295, 1301 (Fed. Cir. 1999). In *Toro*, the court construed the claim terms 'cover' and 'including' to require that the claim elements, the cover and the ring, be attached to one another. In consulting the specification to determine the context in which these claim terms were used, the court held that the only description in the specification of the cover and ring showed that the cover was attached to the ring, and therefore the specification could not support a broader construction for these terms.

(Acacia Br. at 16-17.) Acacia is similarly familiar with the wide body of case law which so holds, as it provides the following additional authority: "*Toro*, 199 F.3d at 1301 ("The specification does not describe an invention broader than this description of the cover and the restriction ring "automatically" inserted and removed together. Nowhere in the specification, including its twenty-one drawings, is the cover shown without the restriction ring attached to it."); *See also Irdeto Access,* *Inc. v. EchoStar Satellite Corp.*, 383 F.3d 1295, 1301 (Fed. Cir. 2004) ("Indeed, the specification consistently uses the term 'group' to refer to a subset of all subscribers. . . . Nowhere does the specification contemplate a single group made up of the entire subscriber base."); *Bell Atlantic Network Servs., Inc. v. Covad Commc'ns, Inc.*, 262 F.3d 1258, 1271 (Fed. Cir. 2001) ("When a patentee uses a claim term throughout the entire patent specification, in a manner consistent with only a single meaning, he has defined the term 'by implication.'")." (Acacia Br. at. 17 n.21.)

Finally, as the Court has correctly observed, where it is clear from the specification that an embodiment is the invention itself, the claims must be limited to that invention. *Modine Mfg. Co. v. United States Int'l Trade Comm'n*, 75 F.3d 1545, 1551 (Fed. Cir. 1996) (*abrogated on other grounds*, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 234 F.3d 558 (Fed. Cir. 2000), *rev'd*, 535 U.S. 722 (2002)); *accord Scimed Life Sys., Inc. v. Advanced Cardiovascular Sys., Inc.*, 242 F.3d 1337, 1343 (Fed. Cir. 2001) ("[T]he characterization of the coaxial configuration as part of the 'present invention' is strong evidence that the claims should not be read to encompass the opposite structure.")

Thus, this Court properly looked to the specification – which the Federal Circuit has called the "the single best guide to the meaning of a disputed term," *Phillips*, 415 F.3d at 1321 – in determining what the patentees meant by the term "transmission system."

2. Application of the law

The Court determined that the patentees used the term "transmission system" to mean the "particular assembly of elements depicted in the drawings and described in the specification." (Markman III at 8:7-9.) The Court therefore construed the claim term "transmission system" to mean the disclosed transmission system. This construction is clearly correct. The patentees used the term "transmission system" in the specification in a manner that is incompatible with its ordinary meaning, demonstrating that they coined a new meaning for the term. Furthermore, the term "transmission system" is not entitled to a construction that covers systems never described or contemplated in the specification. Each of these points is addressed in more detail below.

a) the specification's use of "transmission system" is incompatible with its plain meaning

While arguing that "transmission system" has a plain meaning, Acacia ignores the fact that the use of the term in the specification is not compatible with that plain meaning. The IEEE Dictionary defines "transmission system" as the specific elements that together "transmit signal waves." The "transmission system" disclosed and claimed in the Yurt patents, however, includes many components having nothing to do with the transmission of the signals, such as storage libraries and an identification encoder. The dictionary definition of "transmission system" excludes these components, and therefore does not cover the "transmission system" described in the specification. Although Acacia submitted a declaration of Merrill Weiss stating that the term "transmission system" has a plain meaning, Mr. Weiss never disputes the fact (previously briefed and argued by the Round 3 Defendants) that this plain meaning does not read on the disclosed transmission system. If the Court adopted Acacia's construction, "the disclosed embodiment would not relate to any limitation of the claimed invention, despite the clear link between" the transmission system "discussed in the specification" and the transmission system "called for by the claims." *Honeywell*, 2007 U.S. App. LEXIS 15820, (Benyacar Decl. Ex. H), at *8.

The Round 3 Defendants also submit herewith the declaration of Dr. Stephen Walters confirming, based on his experience and on the technical literature, that the dictionary definition of "transmission system" excludes components that are defined as part of the "transmission system" in the specification. The use of the term in the technical literature makes clear, as does the IEEE definition, that "transmission systems" cannot include components not involved in transmitting signals. These other definitions, like the IEEE definition, focus on the distinct subset of components in information processing and communication systems responsible for transmitting the signals over a communications medium, and the medium itself:

> A transmission system in its simplest form is a pair of wires connecting two telephones. More commonly, a transmission system is a complex aggregate of electronic gear and the associated medium, which together provide a multiplicity of channels over which many customers' messages and associated control signals can be transmitted. In general, a call between two points will be handled by connecting a number of different transmission systems in tandem to form an overall transmission connection between two points. Bell Laboratories, *Transmission Systems for Communications* 1 (5th ed. 1982).[8] (Benyacar Decl. Ex. A.)
>
> Transmission systems exist to provide circuits for transmitting speech and other signals between the nodes of a telecommunications network. . . Present-day transmission systems range in complexity from simple unamplified audio-frequency lines to satellite radiocommunication systems. J.E. Flood & P. Cochrane, *Transmission Systems* 19 (Peter Peregrinus Ltd. 1991); (Benyacar Decl. Ex. B.)
>
> transmission system: Part of a communication system organized to accomplish the transfer of information from one point to one or more other points by means of signals. Alliance for Telecommunications Industry Solutions, *Telecom Glossary 2000* (2001), http://www.atis.org/tg2k/_transmission_system.html; (Benyacar Decl. Ex. C.)

(Walters Decl. ¶ 16.)

A diagram which illustrates this plain meaning of "transmission system" is included in the ATSC Digital Television Standard specification, which is the television industry's standard for over-the-air transmission of digital television signals. The system for broadcasting these television signals is depicted as follows:

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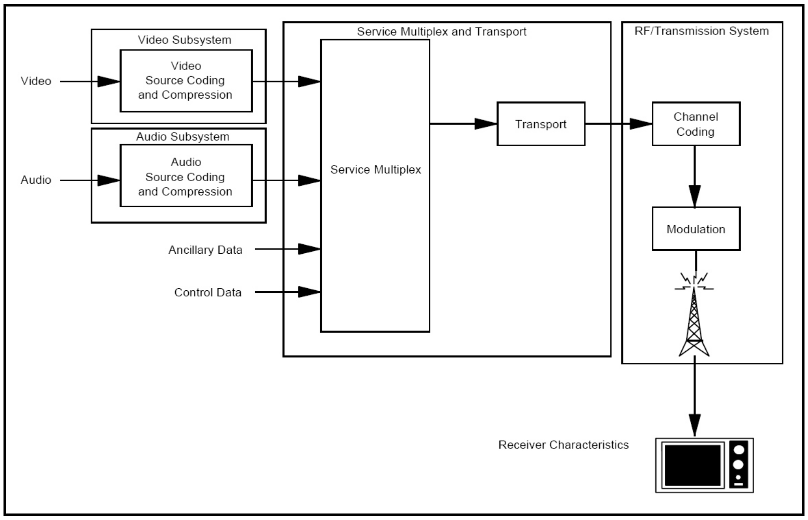
[8] "Transmission system" had the same plain meaning in 1991 as it has today. (Walters Decl. ¶ 18.)



Video Subsystem
Video
Video
Source Coding
and Compression
Audio Subsystem
Audio
Audio
Source Coding
and Compression
Ancillary Data
Control Data
Service Multiplex and Transport
Service Multiplex
Transport
RF/Transmission System
Channel
Coding
Modulation
Receiver Characteristics

Advanced Television Systems Committee, *ATSC Digital Television Standard and Amendment No. 1* 18 (1995). Only those components of the broadcasting system used to format the information specifically for transmission and for placing the signals onto the transmission medium are indicated as being a part of the "transmission system." As this standards document explains:

> 'RF/Transmission' refers to channel coding and modulation. The channel coder takes the data bit stream and adds additional information that can be used by the receiver to reconstruct the data from the received signal which, due to transmission impairments, may not accurately represent the transmitted signal. The modulation (or physical layer) uses the digital data stream information to modulate the transmitted signal.

Id. at 19; (Walters Decl. ¶ 17; Benyacar Decl. Ex. D.)

Likewise, by defining "transmission system" as "an assembly of elements capable of functioning together to **transmit** signal waves," and the word "transmit" to mean "[t]o move data from one location to another location," (Benyacar Decl. Ex. E), the IEEE dictionary definition makes clear that "transmission system" constitutes only those elements which transmit or move the information. (Walters Decl. ¶ 19.) In addition, an alternative definition in the same IEEE dictionary relied upon by Acacia also clearly limits the "transmission system" to the specific components responsible for transmitting the information over a transmission medium and the physical medium itself: "[t]he interface and transmission medium through which peer physical layer entities transfer bits." (Walters Decl. ¶ 20; Benyacar Decl. Ex. E.)

This plain meaning of "transmission system" is not consistent with the use of the term in the specification of the Yurt patents. Pursuant to the plain meaning, the only components of figure 2 that would be part of a "transmission system" are "transmission format conversion CPU" 119, "transceiver" 122 and the various types of media depicted (ISDN, B ISDN, Satellite, etc.) in figure 2b. (Walters Decl. ¶ 21.)[9] As used in the specification, however, all of the devices depicted in series in figures 2a and 2b, from the source material library to the transmitter, are part of the transmission system. The "transmission system" defined in the specification thus includes two storage libraries - a "source material library" for physical items containing information (such as books, still pictures, computer tapes and musical instruments) (col. 5:66-6:34) and a "compressed data library" for information in compressed form (col. 10:31-57.) Storage libraries are antithetical to the functions and objectives of plain-meaning transmission systems because transmission systems are designed to move information, not to store and maintain it. (Walters Decl. ¶ 22.) Similarly, the plain meaning of "transmission system" is incompatible with including an "identification encoder" in a transmission system. According to the specification, an identification encoder performs "storage encoding," which includes assigning unique identification codes and file addresses where information will be stored in the compressed data library. (col. 6:35-54.) As Dr. Walters says, "such codes and addresses have no role in transmission." (Walters Decl. ¶ 23.) Because storage libraries perform the exact opposite function of moving information, and because the source material library, the compressed data library and the identification encoder all relate to saving and retrieving information to and from storage libraries, all three of these components of the patented "transmission system" are incompatible with the plain meaning of "transmission system." (Walters Decl. ¶ 24.)

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[9]As Dr. Walters explains: "'[t]ransmission system' refers to the components that prepare information for real-time transmission (*i.e.,* the information is transmitted immediately after it is prepared for transmission), the components that place information-bearing signals onto a transmission medium, and the physical transmission medium itself." (Walters Decl. ¶ 16.) "[T]he 'transmission format conversion CPU' 119 prepares the information specifically for transmission in real time, the transmitter places the signals onto the medium, and the terms 'ISDN, Satellite' etc. are used to refer to the medium itself." (Walters Decl. ¶ 21.) Therefore, it is only these three components of figure 2 that would be part of a plain-meaning transmission system. (*Id.*) As Dr. Walters also points out, however, only the portion of element 119 which formats the information would be part of the transmission system - not the portion that receives and reacts to user requests. (*Id.* at n.3.)

Other functions performed by the disclosed "transmission system" are also incompatible with the plain meaning of that term. For example, the disclosed "transmission system" receives and processes user requests: "[T]he first step of the distribution method 400 involves retrieving the information for selected items in the source material library 111, upon a request by a user . . . ." (col. 18:53-56); "[t]he transmission format means 119 receives the request and retrieves the composite formatted data block of the requested item stored in compressed data library 118 . . . ." (col. 13:40-43.) Plain-meaning "transmission systems" do not perform this function, as they are not involved in determining what information is to be transmitted. The only function of the transmission system is to move information provided to it from one place to another. (Walters Decl. ¶ 25.)

Not surprisingly, because the only disclosed "transmission system" is incompatible with the plain meaning of the term, there are many claimed method steps which are required to be performed by a "transmission system" which plain-meaning transmission systems cannot perform. Dr. Walters provides the following examples of such method steps (Walters Decl. ¶ 26): "storing items having information in a source material library" ('992 Patent, claim 41); "inputting an item having information into a transmission system" ('863 Patent, claims 14 and 17); "retrieving the information in the items from the source material library" ('992 Patent, claim 41); "assigning a unique identification code to the retrieved information" (*id.* at claim 41); "assigning a unique identification code to the item having information" ('863 Patent, claims 14 and 17); "placing the formatted data into a sequence of addressable data blocks" ('992 Patent, claim 41); "formatting the item having information as a sequence of addressable data blocks" ('863 Patent, claims 14 and 17); and "storing, as a file, the compressed, formatted, and sequenced data blocks with the assigned unique identification code." ('992 Patent, claim 41; '863 Patent, claim 14.)

Dr. Walters also explains that if the dictionary definition of "transmission system" covered all equipment that is connected directly or indirectly to transmitting equipment, as Acacia seems to argue, the term would have no meaning. For example, there would be no way to distinguish a "transmission system" from a "receiving system," because all of the components on any network would be part of the "transmission system." All computers, information processing devices and storage devices directly or indirectly connected to a network would be part of the same single transmission system. In fact, all information processing devices and storage devices on the planet which are directly or indirectly connected to any public network (such as the Internet, the telephone network, etc.), as well as all of these networks themselves, would make up a single transmission system since information can be transmitted from any device to any other device. (Walters Decl. ¶ 27.) Accordingly, the only alternative to construing the term "transmission system" to mean the transmission system disclosed in the specification is to render the term indefinite. (Round 3 Defendants' 8/11/06 Br., Docket No. 198, at 7-10.)

Because the ordinary meaning of "transmission system" is incompatible with its use in the specification and claims, and would exclude the only transmission system disclosed in the specification, it is clear that the patentees coined a new definition for the term "transmission system."

b) the specification defines a single transmission system, which is the invention itself

As the Court has correctly recognized, the specification defines and contemplates *one* transmission system, which is summarized in column 2 under the heading "SUMMARY OF THE INVENTION" and which is more fully described in figures 2a and 2b (and its related text in the specification). The Court therefore properly construed the claim term "transmission system" in view of that disclosed transmission system. (*See supra* at § I(A)(1).) Although Acacia argues that the term "transmission system" is used in the specification to describe a variety of different systems, Acacia is wrong.

Contrary to Acacia's assertion, there is no inconsistency between the system summarized in column 2 and the system depicted in figure 2 of the specification. Column 2 describes an "ordering means . . . for placing the formatted data into a sequence of addressable data blocks; [and] compression means, coupled to the ordering means, for compressing the formatted and sequenced data . . . ." (col. 2:37-41.) Thus, after the sequence of addressable data blocks is created by the ordering means, the data is compressed by the compression means. Similarly, in figure 2a, the sequence of addressable data blocks is created by the time encoder **114**,[10] after which it is formatted for compression by precompressor processor **115** and compressed by compressor **116**. (col. 7:59-col. 8:6.)

Acacia argues that because figure 2a has a precompression processor **115** between time encoder **114** and compressor **116**, the compression means is not "coupled to" the ordering means as required by the description in column 2, and is therefore an alternate embodiment. That is incorrect. As the specification teaches, formatting for compression is a necessary part of compression. (*See, e.g.*, col. 8:67-col. 9:2) ("Video precompression processor **115**b buffers incoming video data and converts the aspect ratio and frame rate of the data, *as required by compression processor* **116**.") Accordingly, one skilled in the art would understand that the precompression processor **115** is part and parcel of the "compression means" that is described in the summary of the invention in column 2. (Walters Decl. ¶¶ 31-33.)[11] Indeed, the specification repeatedly describes precompression processing as part of compression. (*See* col. 7:46-47) ("compression by precompression processor **115** and compressors **128** and **129**"); (col. 8:5-6) ("compression processing by precompression processor **115** and compressor **116**").

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[10]The manner in which data blocks become "addressable" is described in more detail in Section III herein.

Lest there be any doubt, the specification *specifically* describes the precompression processor as part of the "compression means." In particular, the specification states:

> The transmission system **100** of the present invention also preferably[12] includes data compression means for compressing the formatted and sequenced data. The sequence of addressable data blocks which was time encoded and output by the time encoder **114** is preferably sent to precompression processor **115**.

(col. 8:57-62.) Thus, in figure 2a, the ordering means (time encoder **114**) *is* "coupled to" the compression means (precompression processor **115** and compressor **116**). Contrary to Acacia's assertion, there is no inconsistency between the system depicted in figure 2a and the summary of that same system that is set forth in column 2 of the specification.

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[11]Those of ordinary skill in the art would not read a technical specification in such a way that it discloses two embodiments, one of which is inoperative (e.g., employing compression without the required precompression processing), if there is a reasonable way to read the specification such that it describes the same, one operative embodiment. An inoperative embodiment is simply not an alternative embodiment. (Walters Decl. ¶ 36.)

[12]As Acacia itself points out (Acacia Br. at 19-20), the specification's use of the word "preferably" does not imply a broader construction.

Nor is there any merit to Acacia's argument that a transmission system having a "transmitter means coupled to the compressed data storing means," as described at col. 2:46-47, is a different transmission system than is depicted in figure 2b, which shows a "transmission format conversion CPU" **119** between transceiver **122** and the compressed data library **118**. (Acacia Br. at 6-7.) The "transmission format conversion CPU" **119** in figure 2b "converts the compressed formatted data block into a format suitable for transmission." (col. 13:40-45.) Thus, just as the formatter for compression is part of the "compression means," the formatter for transmission is part of the "transmitter means."[13] (Walters Decl. ¶ 35.) Indeed, original claim 2 – on which Acacia itself heavily relies (Acacia Br. at 8) – explicitly states that the "transmission format means" is part of the "transmitter means." (*See* Block Decl. Ex. 1 at claim 2)[14] ("wherein the transmitter means includes: transmission format means . . . .").

In other words, the "transmission format conversion CPU" **119** and the transmitter **122** together comprise the "transmitter means" that is summarized in column 2. Thus, contrary to Acacia's assertion, figure 2b *does* depict a transmitter means coupled to the compressed data storing means. Again, there is no inconsistency.

Next, Acacia argues that the originally-filed claims describe additional, different transmission systems. However, the only originally-filed independent claim that defines the characteristics of a transmission system, claim 1 (Block Decl. Ex. 1 at claim 1), describes the exact same transmission system that is described in column 2 and depicted in figure 2, and *contains every single limitation which the Court included in its construction of "transmission system."* Below is a comparison of originally-filed claim 1 and the Court's construction of "transmission system":

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[13]The disclosed transmission system would not work without the "transmission format conversion CPU" 119. According to the specification, it is element 119 that retrieves the information from the compressed data library after the user requests it. (col. 13:40-45.) Without it, then, there would be no way to transmit the information to the user. Acacia is thus again reading one of several descriptions of the same embodiment in a manner which would render it inoperable, and then relying on this inoperable description as an alternative embodiment.

[14]"Block Decl." herein refers to the Declaration of Alan P. Block in Support of Plaintiff Acacia Media Technologies Corporation's Motion for Reconsideration of Certain Claim Construction Terms Construed by the Court in its Third Claim Construction Order and its Forth Claim Construction Order, filed 5/18/07.

Originally Filed Claim 1 (Block Decl. Ex. 1 at claim 1)	**Court's Construction Of "Transmission System" (Markman III at 8)**
1. A transmission system for providing information to remote locations, the transmission system comprising:	A "transmission system" is "an apparatus which comprises the following interconnected components:"
library means for storing items;	"a source material library means,"
identification encoding means for retrieving the information for the items from the library means and for assigning a unique identification code to the retrieved information;	"an identification encoding means,"
conversion means, coupled to the identification encoding means, for placing the retrieved information into a predetermined format as formatted data;	"a conversion means,"
ordering means, coupled to the conversion means, for placing the formatted data into a sequence of addressable data blocks;	"an ordering means,"
compression means, coupled to the ordering means, for compressing the formatted and sequenced data;	"a compression means,"
compressed data storing means, coupled to the data compression means, for storing as a file the compressed, sequenced data received from the data compression means with the unique identification code assigned by the identification encoding means; and	" a compressed data storing means... and"
transmitter means, coupled to the compressed data storing means, for sending at least a portion of a file to one of the remote locations.	"a transmitter means"

Originally-filed claim 1 thus demonstrates that the Court's construction of "transmission system" is not just the broadest conception of a "transmission system" that the applicants disclosed, it is the very "transmission system" which the applicants described as the broadest invention they had. The Court was thus correct in construing the claim term "transmission system"in accordance with this definition. (*See supra* at § I(A)(1).) The fact that originally-filed dependent claims add additional detail or suggest that additional components can be added to this one transmission system does not constitute a disclosure of "different" transmission systems.[15]

For all of these reasons, *even if* the plain meaning of "transmission system" was broader than (rather than incompatible with) the use of the term in the specification, the Court's construction would still be correct, because the Court's construction captures the broadest conception of "transmission system" that the patentees had and disclosed (as discussed *supra* at § I(A)(1), patentees cannot claim more broadly than what is disclosed in the specification.) As demonstrated in § I(A)(2)(a), however, the plain meaning of "transmission system" is not broader than its use in the specification; it is incompatible with its use in the specification. Therefore, *even if* Acacia was correct and, notwithstanding all of the above facts to the contrary, the specification could be interpreted as describing different transmission systems, *the Court still could not construe "transmission system" in accordance with its plain meaning.* Each of the allegedly different transmission systems would still have storage libraries, an identification encoder and other elements which are incompatible with the plain meaning of "transmission system." Consequently, Acacia's argument that the specification discloses different transmission systems is not only wrong, it is irrelevant.

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[15]Acacia also argues in a footnote that because figures 2a and 2b include details not included in the "summary of invention" in column 2, the figures describe a different system. (Acacia Br. at 7 n.5.) Again, though, a more detailed description of a system does not make it different.

Finally, as the Court observed, the disclosed "transmission system" is repeatedly described by the patentees as the invention itself, a fact which also compels the Court's construction. (Markman III at 7:19-8:11.) The title of all of the asserted Yurt patents is "Audio and Video *Transmission* and Receiving *System*," a title with which, as Acacia admits, the patentees intended to convey the scope of the invention to which the claims were to be limited. (Acacia Br. at 19:5-10.) Moreover, there are many references in the specification, in addition to the two relied on by the Court, (Markman III at 8:1-6), which also describe the disclosed "transmission system" as the invention itself: '992 Patent, col. 1:6-7; 1:62-66; 1:67-2:4; 2:5-10; 2:11-15; 3:24-26; 3:27-29; 3:50-52; 3:54-58; 3:61-64; 3:64-68; 4:1-5; 4:14-18; 4:19-22; 4:30-33; 4:34-36; 4:52-63; 6:35-39; 6:55-58; 7:59-61; 8:57-59; 9:9-12; 13:29-34; 15:61-65; 15:65-67.[16]

For all of the above reasons, the Court's construction of "transmission system" is correct. The Court's construction is entirely consistent with the description of "transmission system" in column 2, in figures 2a and 2b, and in the original claims. Acacia's arguments to the contrary are without merit.

B. There Is No Merit to Acacia's Criticism of the Court's Description of "Transmission System" as a Coined Term

Acacia argues that the Court erred in describing "transmission system" as a "coined term." A coined term, according to Acacia, is something that has absolutely no meaning outside of the patent, such as "ram-a-fram." (Acacia Br. at 3 n.1.) Since the phrase "transmission system" was known, according to Acacia, it is not a "coined term."

[16]Likewise, the inventors characterized the invention as a "transmission system" during prosecution: "[t]he entire system includes a transmission system and a reception system." (Benyacar 5/8/06 Decl., Docket No. 161, Ex. 5 (Petition to Make Special) at 2-3.)

Acacia's argument is much ado about nothing. It is unreasonable to interpret the Court's opinion as stating that the patentees originated the phrase "transmission system." Rather, the Court's meaning was crystal clear: the patentees gave the phrase "transmission system" a *special* meaning that differed from its ordinary meaning. *See Honeywell*, 2007 U.S. App. LEXIS 15820, (Benyacar Decl. Ex. H), at *6.

Acacia's argument that the Court determined "sua sponte" that the patentees used "transmission system" as a coined term, and that "no party has ever contended that" transmission system is a coined term, (Acacia Br. at 3), is both irrelevant and untrue. The Court has sole responsibility for construing the claims, and is not bound by the arguments of any party. *Exxon Chem. Patents, Inc. v. Lubrizol Corp.*, 64 F.3d 1553, 1556 (Fed. Cir. 1995). Moreover, the Round 3 Defendants did brief the fact that the term "transmission system" is used in the Yurt patents in a manner incompatible with its plain meaning. (Round 3 Defendants' 8/11/06 Br. at 4-7.) In addition, counsel stated during oral argument that "in effect, [the patentees] have coined a new term." (9/7/06 Tr. at 29:25-30:1.) Acacia's counsel stated that he understood the Round 3 Defendants' argument to be that the patentees "must have been their own lexicographer." (9/7/06 Tr. at 53:1-2.) Accordingly, Acacia has no basis to claim surprise.

C. There Is No Merit to Acacia's Criticism of the Court's Use of "Means" Language in the Definition of "Transmission System"

Acacia misses the mark when it criticizes the Court for using "means" language in the definition of "transmission system." The Court simply adopted the "means" language that *the patentees* used to describe their "transmission system" invention in the specification. The Court cannot be faulted for employing the very language that the patentees themselves used.

Moreover, although the patentees defined "transmission system" as the system depicted in figures 2a and 2b, the specification's use of "means" language is an attempt to provide a written description of the structural equivalents of each of the particular components of this system. By adopting the specification's "means" language in its construction, the Court afforded the patentees with the benefit of that disclosure, such that the claim term "transmission system" covers both the specific interconnected components of figures 2a and 2b and the structural equivalents of each of those components. It is difficult to understand how Acacia could take issue with the propriety of this.

Finally, Acacia's objection to the "means" language does not in any way support its own proposal that "transmission system" be construed in accordance with its plain meaning (for the reasons described in § I(A) above, the specification precludes that construction.) In effect, Acacia is simply asking the Court to remove the "means" language from its construction and thereby limit "transmission system" to cover only the particular interconnected components of figures 2a and 2b and not any structural equivalents of those components. The Round 3 defendants obviously have no objection to this.

II. THE COURT'S MARKMAN III CONSTRUCTION OF "RECEIVING SYSTEM" IS CORRECT

In Markman III, the Court concluded that the patentees intended "receiving system," like "transmission system," to have a specialized meaning. (Markman III at 10.) Specifically, the Court adopted the following construction:

> an apparatus which directly receives information from the transmission system. The apparatus comprises the following interconnected components: transceiver means, receiver format conversion means, storage means, decompressing means and output data conversion means, as illustrated in Figure 6. The corresponding structure for each means is the structure identified in the specification for performing the recited function. A 'reception system' is the same apparatus as a 'receiving system.' A 'receiving device' is not part of a receiving system.

(Markman III at 11.)

Acacia's criticism of the Court's construction of "receiving system" parallels its criticism of the Court's construction of "transmission system," and is incorrect for all of the same reasons. Nonetheless, Acacia's baseless argument that the patent describes a variety of different receiving systems requires further comment.

The summary of the invention in columns 2-3 of the specification describes ". . . receiver format conversion means . . . for converting the compressed formatted data blocks into a format suitable for storage and processing resulting in playback in real time; storage means, coupled to the receiver format conversion means, for holding the compressed formatted data; [and] decompressing means, coupled to the receiver format conversion means, for decompressing the compressed formatted information . . . ." (col. 3:3-11.) Acacia argues that the receiving system depicted in figure 6 is inconsistent with the system described in the summary of the invention in columns 2-3, because figure 6 shows storage **203** and data formatter **204** in between the receiver format converter **202** and decompressors **205**.

Contrary to Acacia's argument, there is no inconsistency between the receiving system depicted in figure 6 and its summary in columns 2-3. Decompressor **205** contains separate audio and video decompressors **208** and **209**, respectively (col. 18:27-29; Fig. 6.) The function of data formatter **204** is to prepare the compressed data for decompression by "processes[ing] the compressed formatted data blocks and distinguish[ing] audio information from video information." (col. 18:23-26.) Therefore, just as precompression processing is part of the compression means in the transmission system, pre-decompression processing is part of the decompressing means in the receiving system.

Nor is there any inconsistency due to the presence of storage **203** in figure 6. The explanatory text of the specification explains that storage **203** is employed only in one specific situation – when the user wants to play back the requested material at a later time. (col. 18:14-21.)[17] In the situation when playback is desired at the time it is requested, there is no need for temporary storage **203** and the data is sent directly for formatting and decompression. (col. 18:22-29.) Thus, the explanatory text makes it clear that there is another line, not shown in figure 6, between receiver format converter **202** and data formatter **204**. The same two paths (storage for delayed playback; decompression for immediate playback) are outlined in columns 2-3: the receiver format conversion means is coupled to a storage means "for holding the compressed formatted data" for playback at a future time, (col. 3:7-9), and is *also* coupled to a decompressing means for immediate playback without intervening storage. Thus, the *same* configuration is described in both figure 6 and its summary in columns 2-3. There is no inconsistency.[18]

Acacia also relies on originally-filed claims 22 and 23 as support for its contention that the specification discloses different receiving systems. (Acacia Br. at 9-10.) As with "transmission system," however, not only do these originally filed claims not help Acacia, they actually demonstrate that the Court's construction of "receiving system" properly captures the broadest scope of "receiving system" that the patentees contemplated, disclosed and considered their invention. Claim 22, the only independent claim which defines what a receiving system is, *contains*

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[17]"In the reception system **200** of the present invention, the user may want to play back the requested item from the source material library **111** at a time later than when initially requested. *If that is the case*, the compressed formatted data blocks from the receiver format converter **202** are stored in storage **203**. Storage **203** allows for temporary storage of the requested item until playback is requested." (col. 18:14-21) (emphasis added).

[18]According to Acacia's reading of the receiving system description at col. 2-3, the storage means is not coupled to the decompressing means at all. Therefore, there would be no way to decompress and output the data stored in the storage means. Once again, Acacia is reading one description of the only embodiment in a way that would render it inoperable, and is then relying on that inoperable description as an alternative embodiment.

every single limitation which the Court included in its construction of "receiving system." Below is a comparison of originally-filed claim 22 and the Court's construction of "receiving system":

Originally Filed Claim 22 (Block Decl. Ex. 1 at claim 22)	**Court's Construction Of "Receiving System" (Markman III at 11)**
22. A receiving system responsive to a user input identifying a choice of an item stored in a source material library to be played back to the subscriber at a location remote from the source material library, the item containing information to be sent from a transmitter to the receiving system, the receiving system comprising:	A "receiving system" is an "apparatus [which] comprises the following interconnected components:"
transceiver means, for automatically receiving the requested information from the transmitter as compressed formatted data blocks;	"transceiver means,"
receiver format conversion means, coupled to the transceiver means, for converting the compressed formatted data blocks into a format suitable for storage and processing for playback in real time;	"receiver format conversion means,"
storage means, coupled to the receiver format conversion means, for storing the compressed formatted data;	"storage means,"
decompressing means, coupled to the receiver format conversion means, for decompressing the compressed formatted information; and	"decompressing means,"
output data conversion means, coupled to the decompressing means, for playing back the decompressed information in real time at a time specified by the user.	"output data conversion means."

Originally-filed claim 22 thus demonstrates that the Court's construction of "receiving system" is not just the broadest conception of a "receiving system" that the applicants disclosed, it is the very "receiving system" which the applicants described as the broadest invention they had. The Court was thus correct in construing the claim term "receiving system"in accordance with this definition. (*See supra* at § I(A)(1).)

Acacia asserts that the system of originally-filed claim 23 is "different" from the receiving system described in columns 2-3 because it includes a "user interface means." This argument leads nowhere. The statement that the one consistently-described receiving system can also have a "user interface means" does not constitute a "different" embodiment - it is an add-on to the same one embodiment. The Court's construction is consistent with the broadest conception of "receiving system" that the patentees had and disclosed in columns 2-3, in figure 6 and its explanatory text, and in the broadest originally-filed "receiving system" claim. If anything, there is a hint of desperation in Acacia's attempt to rely on a "user interface means," for which there is not even any corresponding structure disclosed in the specification, as a reason that the Court should (i) ignore *all* of the components that are consistently described as being part of the receiving system in columns 2-3 and figure 6; and (ii) construe "receiving system" as any device which receives, notwithstanding the fact that the invention itself is a "transmission and receiving system."[19]

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[19]In footnotes, Acacia takes issue with two other aspects of the Court's construction of "receiving system." (Acacia Br. at 13 n.17-18.) First, Acacia disagrees with the Court's conclusion that the "receiving device" described at col. 18:41 is different from the "receiving system." (Markman III at 10-11.) But the Court was plainly correct. The specification says that the "receiving device" is a playback device "such as a TV or audio amplifier" (col. 18:36-37); it is not the elaborate "receiving system"of figure 6 which performs such functions as storage, format conversion and decompression.

Second, Acacia disagrees with the Court's conclusion that the receiving system must *directly* receive information from the transmission system. This is simply an attempt by Acacia to vitiate the claim limitations that require the transmission system to send to the receiving system. As explained more fully in the Round 3 Defendants' 8/11/06 brief at 67, if the transmission system sends the information to some intermediate system, and that system then sends the information to the receiving system, it was not the transmission system which sent the information to the receiving system at all. That is the reason why the specification uniformly discloses only direct transmission from the transmission system to the receiving system – no intermediary system is ever described. Even Acacia admits that the function of the "receiving system" is to receive the transmission from the "transmission system": "Although the term 'receiving system' is not itself separately defined in the *IEEE Dictionary*, as evidenced by the repeated use of that term in the prior art, **the term 'receiving system' would have been understood by persons of ordinary skill in the art as a system that**

(continued...)

Those of ordinary skill in the art reading the specification would understand the term "receiving system" to refer to the system depicted in figure 6. As Dr. Walters explains, the term "receiving system" does not have a single plain meaning. Those of ordinary skill in the art would understand that its meaning has to be determined by the context in which it is used. When used in conjunction with plain meaning "transmission system," however, those of ordinary skill in the art would understand "receiving system" to refer to the specific components which receive the information-bearing signal from the physical medium and undo the processing for transmission performed by the transmission system. In figure 6, then, that would comprise only transceiver 201 and "receiver format converter" 202. (Walters Decl. ¶ 29.)

In the specification, however, the term "receiving system" is used to refer to the entire system shown in figure 6. Therefore, since the only contextually appropriate plain meaning for the term "transmission system" is incompatible with the use of "receiving system" in the specification, those of ordinary skill in the art would understand that the patentees gave the term a special meaning, and would read the term "receiving system" as used in the patents as meaning the specific, entire system depicted in figure 6. (Walters Decl. ¶ 30.)

Finally, Acacia complains about the Court's use of "means" language in the construction of "receiving system." For the reasons described above in § I(C) with respect to "transmission system," the Court's use of means language was appropriate, and covers the particular interconnected components of figure 6 and their structural equivalents. And, as with "transmission system," Acacia's complaint does not support its own construction ,but rather constitutes a request that the Court remove the "means" language from its construction and thereby limit "receiving

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[19](...continued)
receives the transmitted information from the 'transmission system' . . . ." (Acacia Br. at 13:1-4) (emphasis added).

system" to cover only the particular interconnected components of figure 6 and not any structural equivalents of those components. The Round 3 defendants have no objection to this.

III. THE COURT'S CONSTRUCTION OF "SEQUENCE OF ADDRESSABLE DATA BLOCKS," WHILE CORRECT, SHOULD BE CLARIFIED

Although Acacia submitted extensive briefing on the Court's construction of "sequence of addressable data blocks," (Acacia Br. at 13-20), it is apparent that Acacia, the Round 3 Defendants and the Court are all in substantial agreement as to what is required before data blocks[20] become "addressable." For example, Acacia and the Round 3 Defendants agree that before data blocks can be "addressable," the starting storage location of the file containing those data blocks must be known. (*Id.* at 14-16.) Both Acacia and the Round 3 Defendants also believe that the Court's construction recognizes this requirement: "In its construction, the Court states that '[a]ddressability does not refer to physical storage locations, but rather to positions relative to the beginning of a file containing information.' The Court's construction thus recognizes that 'addressability' in this phrase requires that the starting location of where the file will be stored be known." (*Id.* at 14:11-14.) The Round 3 Defendants believe this requirement should be included expressly in the Court's construction to avoid jury confusion on this issue.

Acacia, the Round 3 Defendants and the Court also all agree that each individual data block is addressable only because its position relative to the starting storage location of the file, the "relative address," must also be known. (*Id.* at 14-16; Markman III at 27-28.) The only disagreement Acacia has with both the Court and the Round 3 Defendants is that Acacia believes that the relative addresses must be time codes.

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[20]The Round 3 Defendants asked the Court to construe "data block" to mean "a unit of information consisting of identification codes, data and error-checking codes." (Round 3 Defendants' 8/11/06 Br. at 43-44.) The Court has not yet construed this term.

We will speak first to the area of disagreement relating to "relative addresses," after which we will propose a clarification to the Court's construction with respect to the agreed requirement that the starting storage location of the file containing the data blocks be known.

A. Relative Addresses Need Not Be Time Codes

Acacia takes issue with the Court's conclusion that "ordering the . . . signals into a sequence of addressable data blocks" "is a very broad limitation which could include time encoding, as well as other ways of generating addressable data blocks." (Markman III at 27.) In other words, the relative addresses need not be limited to time codes, but is broad enough to cover any ordering scheme by which the position of data blocks relative to the staring storage location of the file is known. Acacia argues that the relative addresses should be limited to time codes. (Acacia Br. at 16-20.)

Acacia is wrong. Both the concepts of "addressing" and "relative addressing" are well known,[21] and neither is limited to use of time codes:

> **address** *As a noun*, the value that represents an individually accessible storage location. In a typical computer, each memory location has a separate address. The addresses for the memory system are numbered 0, 1, 2, and so on, up to the maximum possible number of locations supported . . .
>
> *As a verb*, to reference a storage location.

(Benyacar 8/11/06 Decl., Docket No. 197, Ex. E (*Computer Dictionary* (2d ed., Microsoft Press 1994)) at 12.)

> **relative address** . . . A location, as in a computer's memory, that is calculated in terms of its distance (displacement) from a starting point (base address). A relative address is typically computed by adding an offset to the base - in everyday terms, this is similar to creating the address 2001 Main Street, in which the base is the 2000 block of Main Street and the offset is 1, which specifies the first house from the beginning of the block. (Microsoft Dictionary, p. 336.)

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[21] "Addressing" and "relative addressing" had the same meaning in 1991 as they have today. (Walters Decl. ¶ 39.)

(Benyacar 8/11/06 Decl. Ex. E at 336.) Many ways of "addressing" and "relative addressing" other than using time codes are well known. For example, "relative addressing" can be achieved by using simple sequential ordering of data blocks from 1-N in conjunction with the storage location of the start of the file. Those having ordinary skill in the art simply would not understand the concepts of addressing or relative addressing to be limited to the use of time codes.[22] (Walters Decl. ¶ 40.)

Essentially acknowledging this fact, Acacia relies on the same line of cases cited *supra* at § I(A)(1) above and argues that the concept of addressing should be limited to using time codes because only time codes are "disclosed or suggested in the patent specification for achieving addressability." (Acacia Br. at 16-17.) These cases do not permit the Court to limit "sequence of addressable data blocks" to the use of time codes. While it is true that a patentee cannot claim more broadly than what is disclosed in the specification, it is not true that claim terms can always be construed as limited to what is disclosed in the specification. If there is no basis in the specification for construing a claim term to be coextensive with the scope of the disclosure, then the claim does not satisfy the written description requirement, and cannot be judicially rewritten to save its validity. *Liebel-Flarsheim Co. v. Medrad, Inc.*, 358 F.3d 898, 911 (Fed. Cir. 2004).

There are many reasons why the terms "transmission system" and "receiving system" must be construed in accordance with the scope of their use in the specification. For example, the terms are used in the specification in a manner incompatible with their plain meaning, indicating that the patentees coined new meanings for these terms and precluding adoption of the plain meaning as the construction. In addition, the patentees stated that the system depicted in figures 2a and 2b *is* the transmission system, and that the system depicted in figure 6 *is* the receiving system. The entire invention is a new transmission system and receiving system. Indeed, all of the intrinsic evidence, including the originally filed claims, teaches that "transmission system" means figure 2 and "receiving system" means figure 6.

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[22]Acacia also relies on a use of time codes unrelated to addressing. (Acacia Br. at 17-18.) This is irrelevant to the issue of whether or not addressing must be limited to the use of time codes.

None of these factors exist with respect to "sequence of addressable data blocks." For example, the plain meaning of "addressable" is consistent with its use in the specification. The patentees never equate addressability with time codes or in any way define, implicitly or explicitly, addressability to require time coding. The Yurt patents are not directed to new ways to address data blocks. The intrinsic evidence simply does not support, much less compel, limiting "sequence of addressable data blocks" to the use of time codes.

With the claim limitation "sequence of addressable data blocks," the applicants were attempting to claim more broadly than the use of time codes which, as Acacia says, is the only scheme for addressing which is contemplated and disclosed. Because there is no basis in the specification for limiting addressability to time coding, however, the claims fail to satisfy the written description requirement. *Nazomi Commc'ns, Inc. v. Arm Holdings, PLC*, 403 F.3d 1364, 1368 (Fed. Cir. 2005) (the Court "should not rewrite claims to preserve validity.").

B. The Court Should Clarify its Construction to Explicitly State That "Addressable Data Blocks" Means That the Storage Location of the Start of the File Containing the Data Blocks Is Known

As discussed above, both Acacia and the Round 3 Defendants agree that the word "addressable" in the phrase "sequence of addressable data blocks" means that the storage location of the start of the file containing the data blocks is known. (Acacia Br. at 14-16.) It further seems to both of us that the Court intended to incorporate this requirement into its construction with the language "[a]ddressability does not refer to physical storage locations, but rather to *positions relative to the beginning of a file containing information*." (Acacia Br. at 14:11-14) (emphasis added).

However, the Round 3 Defendants respectfully submit that the Court's construction might be confusing to the jury. For example, although it seems that the language "addressability does not refer to physical storage locations" was intended to convey that the individual storage locations of each of the individual data blocks are not separately assigned, the jury may be confused in attempting to reconcile this language with the fact that there is one physical storage location which must in fact be known - the physical storage location of the beginning of the file containing the data blocks. Therefore, the Round 3 Defendants propose that the Court clarify its construction as follows:

> Addressable does not refer to physical storage locations of each of the individual data blocks, but rather to the single known physical storage location of the start of the file containing the data blocks and positions of each of the data blocks relative to that known starting storage location.

IV. THE COURT CORRECTLY ADOPTED ACACIA'S ORIGINAL POSITION THAT "STORING" REQUIRES THE AFFIRMATIVE ACT OF "PLACING"

In construing the phrase "storing items having information in a source material library," the Court observed that "[t]he word 'storing' is an active verb with a common meaning." (Markman III at 30.) The Court held that "words such as 'placing' or 'putting' are appropriate synonyms for 'storing' in the context of Claim 41." (*Id.*)

Although Acacia now challenges the Court's construction, arguing that "storing" should be construed as a passive step ("retaining"), rather than an active step ("placing"), Acacia knows that this challenge is meritless. For nearly three years, Acacia itself consistently, repeatedly and correctly argued to this Court that "storing" does require "placing." Its 180º about-face, which comes for the very first time in its reconsideration motion, is as untimely as it is unsupportable.

A. Throughout this Litigation, Acacia Itself Has Repeatedly and Consistently Argued That "Storing" Requires the Active Step of "Placing" Or "Adding"

Acacia conspicuously fails to mention that it is *Acacia* who originally, and continuously thereafter, advocated "placing" as the proper construction of "storing." In its Claim Construction Brief dated January 8, 2004, Acacia argued that the phrase "storing items having information in a source material library" should be construed as "the act of placing items having information in a source material library for later use . . . ." (Benyacar Decl. Ex. F (Acacia 1/8/04 Br.) at 23.) Acacia specifically emphasized that the word "storing" is used in claim 41 "to describe a definite action – the act of 'storing.'" Acacia repeated the point in its brief in opposition to the Round 1 Defendants' claim constructions. Relying on the same portion of the specification it now relies on in support of the exact opposite proposition (col. 18:53-55), Acacia reiterated that "storing" in the context of claim 41 means "placing." After all, Acacia said, "claim 41 of the '992 is a method claim, and therefore its claim limitations must be acts . . . ." (Benyacar Decl. Ex. G (Acacia 1/22/04 Br.) at 19-20.)[23] The Court accepted Acacia's arguments, and construed "storing items having information in a source material library" to mean "adding"[24] items having information to a collection of existing materials." (Markman I at 25:18-19.)

Acacia modified its position somewhat in 2006, although always including the active requirement of "adding" in its proposed constructions. In its opening brief on the terms for which the Round 3 Defendants sought reconsideration, Acacia asked the Court to change its construction of "storing" from "adding" to "adding *and* maintaining": "[t]he term 'storing should be construed to mean both 'adding' and 'maintaining' and therefore the Court construction should be modified to read as follows: 'adding items having information to a collection of existing materials and maintaining the items having information in the collection.'" (Acacia 7/21/06 Mem., Docket No. 184, at 68.)

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[23]Acacia thus reaches new heights of disingenuousness when it states that it "is not aware of any statute or Federal Circuit case which has ever set forth the legal requirement that every step in method claim be a 'manipulative step or act.'" (Acacia Br. at 21.) Acacia itself provided the following string cite in its 1/22/04 Br., (Benyacar Decl. Ex. G at 20 n.8), for this very proposition: "35 U.S.C. § 101 (permitting claims on 'processes'); Tilghman v. Proctor, 102 U.S. 707, 727 (1880) ('A process is an act, or a mode of acting'); Cochrane v. Deener, 94 U.S. 780, 788 (1876) ('A process is ... an act, or a series of acts')".

[24]"Adding" has the same meaning as "placing" in this context.

Then, after the Round 3 Defendants pointed out that the "storing" limitation lacks written description pursuant to 35 U.S.C. § 112, (Round 3 Defendants' 8/11/06 Br. at 22-23), Acacia changed its mind again, and in its Reply brief asserted that the "storing" limitation should be construed to mean "adding *or* maintaining." (Acacia 8/25/06 Mem., Docket No. 208, at 55-57.) Even Acacia's third proffered construction doesn't save the claim, however. As the Round 3 Defendants explained at the September 7, 2006 Markman hearing, "adding or maintaining" is still broad enough to cover "adding," meaning the phrase "storing items having information in a source material library" still lacks written description. (9/7/06 Tr. at 123:25-124:13.) This is the motivation for Acacia's present, fourth proposed construction of "storing."

Now, *in a reconsideration motion*, Acacia argues for the very first time that "the method does not begin with the placement of any item into the source material library," but rather "storing" means only "retaining." (Acacia Br. at 20-24.) It is respectfully submitted that, in light of this history, the Court should not be receptive to Acacia's new position. *See Liebel-Flarsheim Co. v. Medrad, Inc.*, 481 F.3d 1371, 1380 (Fed. Cir. 2007) (applying the motto "beware of what one asks for" to a patentee who successfully pressed for a certain claim construction only to find that the construction invalidated the patent under 35 U.S.C. § 112).

B. In the Context of Claim 41, "Storing" must Be the Active Step of "Placing"

Acacia's new argument that "storing" does not involve any active "placing" or "adding" is not only inconsistent with its earlier stance, but it is also inconsistent with the language of claim 41. Claim 41 claims a method "comprising . . . steps, *performed* by a transmission system." (emphasis added). The term "performed" describes action, not passivity.[25] Indeed, all of the other steps of claim 41 are active steps – retrieving, assigning, placing, compressing, sending. In context, it is clear that the "storing" step is an active step as well.

Additionally, "[a] claim construction that gives meaning to all the terms of the claim is preferred over one that does not do so." *Merck & Co., Inc. v. Teva Pharms. USA, Inc.*, 395 F.3d 1364, 1372 (Fed. Cir. 2005). Acacia's construction of "storing" to mean "retaining" would vitiate the first step of claim 41, because the second step of the claimed method, "retrieving the information in the items from the source material library," necessarily implies that the items are already present in the source material library – *i.e.,* that they are "retained" there. Thus, under Acacia's construction, the first step, "storing," would be entirely superfluous.

Moreover, Acacia's proposed definition of "storing" as a passive "retaining" step is at odds with the sequential nature of claim 41. As the Court has stated, and as Acacia has admitted,[26] "[t]he language of Claim 41 makes each step antecedent to each succeeding step. . . . [A] step, which is antecedent to a succeeding step, must commence before the succeeding step commences, *and the antecedent step must finish before the succeeding step can finish*." (Markman III at 29) (emphasis added). But under Acacia's proposed construction, the first step – "storing items . . . in a source material library" – is *never* finished, because items remain (that is, they are "retained") in the source material library indefinitely. And given the Court's ruling regarding the order of claim 41's steps, that would mean that the remaining steps of the claim are never finished either – thus destroying the sequential nature of the claim and leading to the ridiculous result that the claimed method could never be completed. It goes without saying that such a construction cannot be proper.

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[25] *See Webster's Collegiate Dictionary* 860 (10th ed. 2001) ("PERFORM implies action that follows established patterns or procedures or fulfills agreed upon requirements . . . .").

[26] See Acacia's 4/17/06 Brief, Docket No. 145-2, at 56-57: "The steps of claim 41 of the '992 patent must be performed in the following order: . . . .", and thereafter reciting all of the steps of claim 41 in the order they appear in the claim.

Thus, to preserve both the sequential nature of claim 41 and any rational meaning of the claim pursuant to which the practice of it can be successfully completed, each step must be discrete in time – it must have a beginning and an end. An active step ("placing") satisfies that requirement, while a passive step ("retaining") does not.[27]

Even Acacia seems to agree. In response to the Court's request for additional briefing on when the "generating" step of claim 46 takes place, Acacia answered that the step takes place "after either the items . . . are stored in the source material library or after the files having the compressed, formatted, sequenced data blocks are stored." (Acacia 5/23/07 Claim 45-46 Br., Docket No. 241, at 3.) By saying that the "generating" step takes place "after" the items are stored, Acacia necessarily acknowledged that the "storing" step is the temporally discrete, active step of placing the items in the source material library (otherwise, the generating step would be concurrent with the storing, and could not occur "after" the items are stored). As Acacia recognized, one simply cannot order the steps unless "storing" is interpreted as the discrete, active step of "placing."

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[27]The example provided by Acacia of leaving a pan in an oven for 45 minutes before removing it from the oven, (Acacia Br. at 22), is not analogous for at least two reasons: (i) the step of leaving the pan in the oven gets completed, meaning the claimed method can be completed; and (ii) the pan is being heated when it is in the oven, which is an active step - simply "retaining" for an indefinite period is not active.

Thus, the language and structure of claim 41 confirm the Court's construction of "storing" as an active verb, synonymous with "placing" or "putting."

C. The Patentees' Use of the Word "Inputting" in Claim 14 of the '863 Patent Supports the Court's Construction of "Storing"

Acacia argues that because claim 14 of the '863 patent uses the word "inputting" – which everyone agrees means "putting in" – the term "storing" in claim 41 of the '992 patent cannot have the same meaning. Quite the contrary. The patentees used the words "inputting" and "storing" interchangeably; in the context of claim 41, they mean the same thing.

Acacia misstates and oversimplifies the law when it asserts that there is a presumption that different claim terms have different meanings. "[W]here neither the plain meaning nor the patent itself commands a difference in scope between two terms, they may be construed identically." *Power Mosfet Techs., LLC v. Siemens AG*, 378 F.3d 1396, 1410 (Fed. Cir. 2004). As the Federal Circuit explained in *Curtiss-Wright Flow Control Corp. v. Velan, Inc.,* 438 F.3d 1374, 1380 (Fed. Cir. 2006) (emphasis added):

> Different claims with different words can, of course, define different subject matter within the ambit of the invention. On the other hand, *claim drafters can also use different terms to define the exact same subject matter.* Indeed, this court has acknowledged that two claims with different terminology can define the exact same subject matter.

Here, it is clear that the same step – "the exact same subject matter" – was described by the patentees in two different ways: "storing items having information in a source material library," ('992 Patent, claim 41), and "inputting an item having information into the transmission system," ('863 patent, claim 14.) The two phrases are worded differently, but describe the same step.

Acacia argues that the specification does not describe placing items in the source material library. While true, this argument does not advance Acacia's claim construction. The lack of a written description in the specification did not prevent the patentees from including an "inputting" step in claim 14 of the '863 patent. By the same token, it did not prevent the patentees from including the same substantive step in claim 41 of the '992 patent.

V. THE COURT CORRECTLY CONCLUDED THAT CLAIM 45 OF THE '992 PATENT IS ARGUABLY INDEFINITE

The Court recognized that dependent claim 45 of the '992 patent cannot be reconciled with claim 41 from which it depends, and that the specification does not help to resolve claim 45's ambiguity because the claim is directed to a method which is not even described in the specification. Therefore, the Court correctly held that claim 45 is "arguably indefinite" without the need for, without requesting and without authorizing any further briefing on the subject.[28]

Claim 45 recites:

> 45. A transmission method as recited in claim 41, wherein the storing step further comprises the step of:
>
> separately **storing a plurality of files**, each including compressed, sequenced data blocks.

The referenced "storing step" of claim 41 is "storing, **as a file**, the compressed, formatted, and sequenced data blocks with the assigned unique identification code." The subsequent step of claim 41 is "sending at least a portion of **the file** to one of the remote locations." As the Court pointed out, the specification does not describe storage in multiple files as a step of any disclosed method, and there is therefore no intrinsic evidence to help resolve the insoluble facial ambiguity of claim 45 with respect to how "multiple files" are used in the method of claim 41. The Court therefore concluded that the phrase "separately storing a plurality of files" is arguably indefinite. (Markman III at 33.)

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[28]Acacia states that the "Court sought additional information [with respect to] whether claim 45 of the '992 is indefinite," and that its arguments with respect to claim 45 are therefore "not reconsideration issues." (Acacia 5/23/07 Br. at 1:2-5.) This is simply untrue. The Court addressed claim 45 in Markman III at 32:24-33:12, and did not seek or permit any additional briefing therein with respect to claim 45 or the Court's conclusion that the claim is arguably indefinite. If Acacia desired reconsideration of the Court's ruling with respect to claim 45, it should have complied with the Court's April 26, 2007 Order and submitted a timely brief.

In all events, because Acacia did not comply with the Court's April 26, 2007 Order with respect to any of the arguments made in its 5/23/07 brief on the grounds that those arguments "are not reconsideration issues," Acacia is not entitled to a Reply brief with respect to any of those arguments.

A. Acacia Mischaracterizes the Court's Opinion

The gist of Acacia's argument is that the specification discloses storage devices, such as the compressed data library **118**, which hold more than one file. But as set forth below, the Court specifically took note of that fact – and found it irrelevant. Specifically, the Court observed that "'separately storing a plurality of files' is an attribute of the compressed data storing means **118**," but "[t]he attribute of being capable of storing a plurality of files does not lend itself to conversion to a manipulative step." (Markman III at 33 n.12.) In other words, there is no disclosure of a method which processes related data, assigns that data a single unique identification code, and later stores related data in separate files.

Acacia ignores the fact, recognized by the Court, that the claim 45 step – "separately storing a plurality of files" – must relate to the "method of transmitting information to remote locations" that is set forth in claim 41, from which claim 45 depends. The question then arises: how does "separately storing a plurality of files" fit into the method of storing items in a source material library; retrieving information from those items; assigning a unique identification code; formatting, sequencing and compressing the data; "storing, ***as a file***, the compressed, formatted and sequenced data blocks"; and "sending at least a portion ***of the file*** to one of the remote locations"? The specification does not say.

In sum, the specification does not describe using multiple files *in the claimed method.* To the contrary, the data that is transmitted to the remote location is taken from "a file" (singular). Thus, the Court was quite right to conclude that the patent does not describe any method of transmitting information in which the information subject to the method is stored in a plurality of files. Thus, claim 45 not only lacks written description, there is no disclosure to rely on to resolve the facial ambiguity of claim 45.

B. Claim 45 is indefinite

Claim 45 is indefinite because it is insolubly ambiguous.

First, it is unclear how “separately storing a plurality of files, each including compressed, sequenced data blocks” is used in the method of transmitting information to remote locations. As set forth above, the specification does not describe using a plurality of files in such a method.

Second, claim 41 requires that the compressed, formatted, and sequenced data blocks be stored in a *single* file, while claim 45, which depends from claim 41, requires that the compressed, sequenced data blocks be stored in a *plurality* of files. Thus, claim 45 alters the single-file limitation of claim 41, in violation of 35 U.S.C. § 112 ¶ 4, which requires a dependent claim to “incorporate by reference all of the limitations of the claim to which it refers.” A claim which alters an independent claim instead of limiting it is invalid. *Pfizer Inc. v. Ranbaxy Labs. Ltd.*, 457 F.3d 1284, 1291-92 (Fed. Cir. 2006).

Third, claim 45 incorporates by reference the limitation of claim 41 of “sending at least a portion *of the file* [singular] to one of the remote locations.” The claim is indefinite because it is impossible to know *which one* of the “plurality of files” is to be sent.

VI. THERE IS NO WAY TO TELL WHEN THE STEP “GENERATING A LISTING OF AVAILABLE ITEMS” IN CLAIM 46 TAKES PLACE

The Court asked for further briefing on when the element of claim 46, “generating a listing of available items,” takes place. (Markman III at 33.) Acacia states that this step occurs after items are “available,” and before the next step of claim 46 (“receiving transmission requests”) takes place. (Acacia 5/23/07 Br. at 2-3.) The fact is, however, that there is no way to tell when the "generating" step occurs, because the specification does not describe "generating a listing of available items" at all, much less the performance of such a step in a method of transmitting information.

Acacia cites two passages of the specification (col. 13:29-47, 18:53-19:10) for the proposition that the step of "generating a listing of available items" occurs *either* after the items having information are stored in the source material library, or after the files having the compressed, formatted, and sequenced data blocks are stored. (*Id*. at 3.) However, neither of these passages say anything about generating a list of available items. In fact, although various portions of the specification mention the existence of a listing of available items or titles,[29] the specification does not describe (i) the generation of such a list; (ii) when such a listing is generated; or (iii) the step of generating as part of a method for transmitting information. Accordingly, the "generating" step of claim 46 is not only indefinite, it also lacks written description.[30]

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[29](*See* col. 3:58-59) (the user "chooses audio and/or video material from a list of available items"); (col. 11:34-35) ("a catalog listing some or all available titles may also preferably be published"); (col. 17:44-46) ("[t]he library access interface **121** in the reception system **200** preferably includes a title window where a list of available titles are alphabetically listed.").

[30]To the extent the language of the claims provide any suggestion as to when the "generating" step occurs, one would deduce that this step, like all of the steps of claim 46, have to be performed after the claim 41 step of "placing the retrieved information into a predetermined format as formatted data," but before the claim 41 steps of "placing the formatted data into a sequence of addressable data blocks" and "compressing the formatted and sequenced data blocks." The reason for this is that the last step of claim 46 refers to retrieving "formatted data blocks," whereas in claim 41, after the sequencing and compressing steps, the claim requires storing "compressed, formatted *and* sequenced data blocks." Therefore, claim 46 would suggest that its steps take place after formatting, but before sequencing and compression.

VII. ACACIA'S ATTEMPT TO REWRITE THE SPECIFICATION AT COL. 17:44-53 SHOULD BE REJECTED

In conjunction with its discussion of claim 46, the Court questioned whether the specification at col. 17:44-53 is in error and should read "in transmission system as shown in figure **2b**" instead of "in the reception system **200**." (Markman III at 33-34.) There is no reason to believe that this passage from the specification is a mistake. The purpose of a "title window where a list of available titles are alphabetically listed," which the specification clearly says is part of the library access interface 121, is obviously to display to the *user* a list of choices, so that the *user* can select what he wishes to receive. Perforce, this title window, and the library access interface it is a part of, must be located at the reception system where a user is located – not at the transmission system.

To be sure, the specification of the Yurt patents is not a model of clarity. But it was the statutory duty of the patentees to include a written description in "full, clear, concise and exact terms". 35 U.S.C. § 112 ¶ 1. When a patentee fails to meet that standard, the proper course is not to judicially rewrite the patent, but to invalidate it.

CONCLUSION

For the foregoing reasons, the Court should clarify its construction of "sequence of addressable data blocks," and should otherwise adhere to its Markman rulings. Further proceedings in the case should be based on the claim constructions contained in those rulings.

Respectfully submitted,

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KAYE SCHOLER LLP

/s/ David S. Benyacar
David S. Benyacar
Daniel L. Reisner
425 Park Avenue
New York, NY 10022-3598
Tel.: (212) 836-8000
Fax: (212) 836-8689
dbenyacar@kayescholer.com
dreisner @kayescholer.com

Attorneys for Defendant
Time Warner Cable Inc.

GOODWIN PROCTER LLP

/s/ Benjamin Hershkowitz
Benjamin Hershkowitz
John F. Petrsoric
599 Lexington Avenue
New York, NY 10022
Tel.: (212) 813-8800
Fax: (212) 355-3333
bhershkowitz@goodwinprocter.com
jpetrsoric@goodwinprocter.com

Attorneys for Defendant
CSC Holdings, Inc.